

Serial No.: 09/705,579

REMARKS

The undersigned confirms having met with Examiner Yaen in the interview on September 27, 2006. At that time, Applicant indicated that (1) all claims other than allowed claim 71 would be cancelled and (2) a new petition to withdraw a previously filed terminal disclaimer would be filed. Accordingly, claims 69 and 70 are cancelled herein *without prejudice or disclaimer*, so that this case can proceed to allowance. The sole remaining claim in the case following entry of this amendment will be allowed claim 71.

By allowing claim 71, the Examiner indicates that such claim is non-obvious over US Patent No. 5,720,954, Hudziak et al. ("the '954 patent") in view of Pauwels et al. Earlier in prosecution, the Office had relied on the '954 patent in rejecting the then-pending claims 42, 44, 55, 63, and 65 under the judicially created doctrine of obviousness-type double patenting (Office Action dated June 3, 2003, pages 3-4). At that time, Applicant filed a terminal disclaimer (TD) over the '954 patent and explained that such TD was being submitted in "order to expedite prosecution, and without acquiescing in the rejection." Since filing that TD, claims 42, 44, 55, 63, and 65 have been cancelled, and the Office has found that newly presented claim 71 herein is non-obvious over the '954 patent (Office Action dated July 12, 2006, page 5). Thus, Applicant now petitions to withdraw the previously recorded TD. A petition under 37 CFR 1.182 requesting withdrawal of the recorded TD is attached. Applicant notes that a Decision on Petition dated June 22, 2006, dismissed an earlier-filed petition requesting withdrawal of the TD, but a new petition with newly presented facts is submitted herewith.

Further to the Statement of Related Cases filed March 1, 2004, Applicant respectfully requests that the Examiner also consider co-pending case, USSN 10/909,998, filed August 2, 2004 (Atty Docket no. P1256R3C1), with respect to the present application.

Applicants look forward to early receipt of the decision granting the new petition and the notice of allowance in due course.

Date: September 28, 2006

Respectfully submitted,  
GENENTECH, INC.  
By: /Wendy M. Lee/  
Wendy M. Lee  
Reg. No. 40,378  
Telephone: (650) 225-1994